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1 a desired state in the directory.” (citing to Bowman, column 117, lines 24-37). The
2 Office admits that Bowman does not teach or suggest “automatically detecting a
3 state change to an object in a directory; and responsive to the state change.”
4 However, the Office argues that Berg teaches this subject matter and that it would
5 have been obvious to one with skill in the art to combine Bowman with Berg. For
6 a number of reasons, Applicant disagrees with the Office and submits that the
7 Office has failed to make out a *prima facie* case of obviousness.

8 First, the Office has failed to make out a *prima facie* case of obviousness
9 because the motivation given to modify Bowman with Berg does not make sense.
10 Specifically, in order to make out a *prima facie* case of obviousness, there is a
11 requirement that there must be some reason, suggestion, or motivation *from the*
12 *prior art*, as a whole, for the person of ordinary skill to have combined or
13 modified the references. *See, In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir.
14 1987). In this case, the Office argues that one would modify Bowman with Berg
15 because “by updating the state of the workflow instance in this manner all users
16 working on the same instance of a workflow share the same view of the workflow
17 as taught by Berg in the method of Bowman-Armuah to *reduce the amount of*
18 *deficiencies* in the process of performing and managing complex processes.”
19 (Office Action, page 3). This statement by the Office implies that Bowman or
20 Berg is deficient in the process of performing and managing complex processes.
21 However, the Office has not directed Applicant to a section of Bowman or Berg
22 that states this deficiency. Furthermore, a careful reading of Bowman and Berg as
23 well as a keyword search of Bowman and Berg reveals that there is no mention in
24 Bowman or Berg of a need to reduce deficiencies in the process of performing and
25 managing complex processes. Therefore, there is no reason, suggestion, or

1 motivation *from the prior art* that teaches the deficiency that the Office claims
2 exists. Accordingly, because Bowman and Berg are not deficient in the process of
3 performing and managing complex processes, one with skill in the art would not
4 be motivated to modify Bowman with Berg. For at least this reason, the Office has
5 failed to make out a *prima facie* case of obviousness.

6 Furthermore, the Office has failed to make out a *prima facie* case of
7 obviousness because the Office has used hindsight reconstruction to combine
8 Bowman and Berg. Established case law makes it clear that it is impermissible to
9 use the claimed invention as an instruction manual or “template” to piece together
10 the teachings of the prior art so that the claimed invention is rendered obvious.
11 One cannot use hindsight reconstruction to pick and choose among isolated
12 disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23
13 USPQ 2d 1780, 1784 (Fed. Cir. 1992). As shown above, there is no reason,
14 suggestion, or motivation in Bowman or Berg that suggests a need to reduce the
15 amount of deficiencies in the process of performing and managing complex
16 processes. Therefore, the only logical explanation for the Office’s combination is
17 that the Office has used Applicant’s disclosure as a template to piece together
18 Bowman and Berg. Upon analyzing the cited portion of Berg, Applicant notes that
19 the words “workflow,” “state,” and “change” appear multiple times. Therefore, it
20 is clear to Applicant that the Office, realizing that Bowman did not teach detecting
21 a state change in a directory object, did a keyword search for the words “work
22 flow,” “state,” and “change.” The Office then attempted to piece together Bowman
23 and Berg by claiming that the references were deficient in some manner. Thus, the
24 Office clearly has used Applicant’s disclosure as a template to piece together
25 Bowman and Berg. As noted above, this is hindsight reconstruction, which is

1 impermissible to use in making out a *prima facie* case of obviousness. For this
2 additional reason, the Office has failed to make out a *prima facie* case of
3 obviousness.

4 For similar reasons as discussed above, the Office has failed to make out a
5 *prima facie* case of obviousness because the motivation given by the Office is too
6 general. The Office has provided a paper that describes proper and improper
7 rejections made under §103(a). Particularly instructive is Example 17 that appears
8 in Section V of the paper illustrating an improper §103(a) rejection which is based
9 upon a proposed motivation that is simply too general and lacking in particularity.
10 This example is reproduced below in its entirety for the Office's convenience:

11 **V. Examples of Improper Rejection under 35 U.S.C. 103**

12 Example 17: Improper rejection based upon hindsight - general motivation
13 statement.

14 **a. The claimed invention**

15 The invention is drawn to a smart card containing a tracking
16 mechanism, which tracks shopping preferences of consumers by recording
17 the type, quantity, and dates of purchase for a pre-selected group of
18 products. The smart card is useful in a system and method for introducing
19 new and alternative products that are of the same type as products normally
20 purchased by the shopper. The smart card records the shopper's purchases
21 and submits an automatic notification to the shopper when a quantity
threshold is achieved for the pre-selected products. This notification will
encourage the consumer to consider alternative products by providing the
consumer incentives, such as a pricing discount, to purchase an alternative
product.

22 **Claim 1:**

23
24 A method for using a smart card in a marketing analysis program
25 designed to introduce new products, the method comprising the steps of:

1 storing product information on the smart card when said
2 products are purchased by a consumer wherein said information
3 including type, quantity and dates of the product purchased;

4 identifying for each product a threshold for each of said type,
5 quantity and dates of products purchased;

6 determining an incentive for an alternative product based on
7 said threshold; and

8 automatically notifying said consumer when said threshold is
9 reached for a given product identified on the smart card and
10 providing the consumer with said incentive, whereby the incentive
11 encourages the consumer to consider alternative products.

12 **b. Evidence**

13 Reference A discloses smart card that tracks consumer preferences
14 by recording the type, quantity, and dates of purchase of pre-selected
15 products to determine trends in consumer purchases. The smart card is
16 periodically read by a scanner to determine its contents for market analysis.
17 In return for using the smart card and participating in the marketing
18 program, the user is provided with free product coupons for products that
19 are normally purchased by the shopper.

20 Reference B discloses a traditional consumer incentive program that
21 provides coupons for the purchase of named products based upon the
22 consumer's purchase of those same products to promote customer loyalty.

23 **c. Poor statement of the rejection**

24 Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over
25 Reference A in view of Reference B. Reference A discloses the
conventional use of a smart card to track consumer preferences and provide
incentives. However, Reference A does not disclose the automatic
notification to consumer providing incentives. Reference B discloses
providing incentives to consumers to purchase the desired products. *It
would have been obvious to combine Reference A's smart card with
Reference B's incentive to consumers because the combination would
allow Reference A's smart card to be more efficient.*

d. Analysis

1 *The motivation, improve efficiency, is too general because it could*
2 *cover almost any alteration contemplated of Reference A and does not*
3 *address why this specific proposed modification would have been obvious.*
4 Additionally, there is nothing in either of references that would suggest
5 automatically notifying the consumer when reaching a threshold nor is
6 there anything in either reference that would suggest the notifying step.
7 Finally, although Reference B teaches a traditional coupon scheme to
8 promote customer loyalty, there is no suggestion, other than applicant's
9 disclosure, to employ this scheme to promote the introduction of new and
10 alternative products. **The rejection is improper.**

11 As noted above, *the motivation to improve efficiency, is too general*
12 *because it could cover almost any alteration contemplated and does not address*
13 *why a specific proposed modification would have been obvious.* Similarly, the
14 Office's proposed modification to *reduce deficiencies* is too general because it
15 could cover almost any alteration contemplated. In order for the Office to give this
16 motivation, the Office must explain or show why Bowman is deficient in
17 performing and managing complex processes. Since the Office has failed to do so,
18 the Office has failed to make out a *prima facie* case of obviousness for this
19 additional reason.

20 Finally, in making out the rejection, the Office admits that Bowman does
21 not automatically *detect* a state change to an *object in a directory* and does not
22 teach a response to that state change. However, the Office claims that Bowman
23 does teach a computer-implemented method for implementing workflow
24 *responsive to a directory object state change.* In other words, the Office claims
25 that Bowman *responds* to a state change to an object in a directory without ever
 detecting the state change. This is confusing to Applicant. Applicant questions
 how one can respond to a state change without ever detecting a state change.
 Applicant submits that Bowman does not respond to a directory object state

1 change. Therefore, the combination given does not teach or suggest a computer-
2 implemented method for implementing workflow *responsive to a directory object*
3 *state change*. For this additional reason, the Office has failed to make out a *prima*
4 *facie* case of obviousness.

5 For all of the reasons mentioned above, the Office has failed to make out a
6 *prima facie* case of obviousness. Accordingly, this claim is allowable.

7 **Claims 2-18** depend from claim 1 and are allowable as depending from an
8 allowable base claim. These claims are also allowable for their own recited
9 features which, in combination with those recited in claim 1, are neither shown nor
10 suggested by the combination of Bowman and Berg.

11 **Claim 19** recites a computer-readable medium comprising computer-
12 executable instructions to implement workflow responsive to a directory object
13 state change, the computer-executable instructions comprising instructions for:

- 14 • detecting a state change to an object in a directory; and
- 15 • responsive to detecting the state change:
 - 16 ○ mapping the state change to the object to a workflow comprising
 - 17 a set of tasks; and
 - 18 ○ executing the tasks to achieve a desired state in the directory.

19 In making out the rejection of this claim, the Office uses the same argument
20 as was used in making out the rejection of claim 1. Accordingly, for the same
21 reasons as discussed with regards to claim 1, Applicant submits that the Office has
22 failed to make out a *prima facie* case of obviousness. Specifically, the motivation
23 given by the Office does not make sense and is too general. Furthermore, the
24 Office has used hindsight reconstruction in making out the rejection. Finally, the
25 combination of Bowman and Berg, as discussed above, does not teach or suggest a

1 computer-readable medium comprising computer-executable instructions to
2 implement workflow *responsive to a directory object state change*.

3 For all of these reasons, the Office has failed to make out a *prima facie* case
4 of obviousness. Accordingly, this claim is allowable.

5 **Claims 20-36** depend from claim 19 and are allowable as depending from
6 an allowable base claim. These claims are also allowable for their own recited
7 features which, in combination with those recited in claim 19, are neither shown
8 nor suggested by the combination of Bowman and Berg.

9 **Claim 37** recites a computing device comprising:

- 10
- 11 • a memory comprising computer-executable instructions for
12 automatically implementing workflow responsive to a directory object
13 state change; and
 - 14 • a processor coupled to the memory for executing the computer-
15 executable instructions, the computer-executable instructions
16 comprising instructions for:
 - 17 ○ detecting a state change to an object in a directory; and
 - 18 ○ responsive to detecting the state change:
 - 19 ■ mapping the state change to the object to a workflow
 - 20 comprising a set of tasks; and
 - 21 ■ executing the tasks to achieve a desired state in the
 - 22 directory.

23 In making out the rejection of this claim, the Office uses the same argument
24 as was used in making out the rejection of claim 1. Accordingly, for the same
25 reasons as discussed with regards to claim 1, Applicant submits that the Office has
failed to make out a *prima facie* case of obviousness. Specifically, the motivation
given by the Office does not make sense and is too general. Furthermore, the
Office has used hindsight reconstruction in making out the rejection. Finally, the
combination of Bowman and Berg, as discussed above, does not teach or suggest a

1 memory comprising computer-executable instructions for automatically
2 implementing workflow *responsive to a directory object state change*.

3 For all of these reasons, the Office has failed to make out a *prima facie* case
4 of obviousness. Accordingly, this claim is allowable.

5 **Claims 38-54** depend from claim 37 and are allowable as depending from
6 an allowable base claim. These claims are also allowable for their own recited
7 features which, in combination with those recited in claim 37, are neither shown
8 nor suggested by the combination of Bowman and Berg.

9 **Claim 55** recites a computing device comprising automated processing
10 means for:

- 11 • detecting a state change to an object in a directory; and
- 12 • responsive to detecting the state change:
 - 13 ○ mapping the state change to the object to a workflow comprising
 - 14 a set of tasks; and
 - 15 ○ executing the tasks to achieve a desired state in the directory.

16 In making out the rejection of this claim, the Office uses the same argument
17 as was used in making out the rejection of claim 1. Accordingly, for the same
18 reasons as discussed with regards to claim 1, Applicant submits that the Office has
19 failed to make out a *prima facie* case of obviousness. Specifically, the motivation
20 given by the Office does not make sense and is too general. Furthermore, the
21 Office has used hindsight reconstruction in making out the rejection.

22 For all of these reasons, the Office has failed to make out a *prima facie* case
23 of obviousness. Accordingly, this claim is allowable.

24 **Claims 56-72** depend from claim 55 and are allowable as depending from
25 an allowable base claim. These claims are also allowable for their own recited

1 features which, in combination with those recited in claim 55, are neither shown
2 nor suggested by the combination of Bowman and Berg.

3 **Claim 73** recites a computer-readable medium comprising workflow
4 enabled directory schema for automated workflow implementation by a set of
5 computer-program instructions executable by a processor, the workflow enable
6 directory schema comprising a plurality of base object content classes comprising:

- 7
- 8 • a provisioning service content class to detect an event corresponding to
a state change in a directory object;
- 9 • a workflow content class for storing a sequence of tasks;
- 10 • an event association content class for storing declarative conditions to
map the state change to the directory object to an object instance of the
workflow content class; and
- 11 • wherein the provisioning service content class is further configured to
12 execute the sequence of tasks corresponding to the object instance.
- 13

14 In making out the rejection of this claim, the Office argues that Berg
15 teaches “a computer-readable medium comprising workflow enabled directory
16 schema for automated workflow implementation by a set of computer-program
17 instructions executable by a processor, the workflow enable directory schema
18 comprising a plurality of base object content classes comprising: a provisioning
19 service content class to detect an event corresponding to a state change in a
20 directory object.” (citing to Berg, col. 7, lines 56-63). The Office then argues that
21 Bowman teaches “a workflow content class for storing a sequence of tasks; an
22 event association content class for storing declarative conditions to map the state
23 change to the directory object to an object instance of the workflow content class;
24 and wherein the provisioning service content class is further configured to execute
25 the sequence of tasks corresponding to the object instance.” Applicant notes that

1 the Office has not provided Applicant with a suggestion or motivation from the
2 prior art as to why one would combine Bowman and Berg in this manner. As such,
3 Applicant submits that the Office has failed to make out a *prima facie* case of
4 obviousness.

5 As set forth in MPEP §§2142 and 2143, a *prima facie* case of obviousness
6 has three basic requirements. First, there must be some *suggestion or motivation,*
7 *either in the references themselves or in the knowledge generally available to*
8 *one of ordinary skill in the art, to modify the reference or to combine reference*
9 *teachings.* Second, there must be a reasonable expectation of success. Finally,
10 the prior art reference (or references when combined) must teach or suggest all the
11 claim limitations. In this case, the Office has not provided Applicant with any
12 suggestion or motivation as to why one with skill in the art would modify
13 Bowman with Berg in this manner. As such, the Office has failed to make out a
14 *prima facie* case of obviousness. For at least this reason, this claim is allowable.

15 **Claims 73-76 and 78** depend from claim 72 and are allowable as
16 depending from an allowable base claim. These claims are also allowable for their
17 own recited features which, in combination with those recited in claim 72, are
18 neither shown nor suggested by the combination of Bowman and Berg.

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3 **Conclusion**

4 All of the claims are in condition for allowance. Accordingly, Applicant
5 requests a Notice of Allowability be issued forthwith. If the Office's next
6 anticipated action is to be anything other than issuance of a Notice of Allowability,
7 Applicant respectfully requests a telephone call for the purpose of scheduling an
8 interview.

9
10
11 Dated: 6/30/06

Respectfully Submitted,

By: 

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